

IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): PHILLIPS ET AL.

Confirmation No.: 2177

Application No.: 09/924,200

Examiner: BEATTY

Filing Date: 08/07/2001

Group Art Unit: 2852

Title: CASSETTE LOADING OF PRINTING CONSUMABLES

COMMISSIONER FOR PATENTS
Washington, D.C. 20231

TRANSMITTAL LETTER FOR RESPONSE/AMENDMENT

Sir:

Transmitted herewith is/are the following in the above-identified application:

- (X) Response/Amendment () Petition to extend time to respond
() New fee as calculated below () Supplemental Declaration
() No additional fee (Address envelope to "Box Non-Fee Amendments")
() Other: (fee \$)

CLAIMS AS AMENDED BY OTHER THAN A SMALL ENTITY						
(1) FOR	(2) CLAIMS REMAINING AFTER AMENDMENT	(3) NUMBER EXTRA	(4) HIGHEST NUMBER PREVIOUSLY PAID FOR	(5) PRESENT EXTRA	(6) RATE	(7) ADDITIONAL FEES
TOTAL CLAIMS	20	MINUS		= 20	X \$18	\$ 360
INDEP. CLAIMS		MINUS		= 0	X \$84	\$ 0
[] FIRST PRESENTATION OF A MULTIPLE DEPENDENT CLAIM					+ \$280	\$ 0
EXTENSION FEE	1ST MONTH \$110.00	2ND MONTH \$400.00	3RD MONTH \$920.00	4TH MONTH \$1440.00		\$ 0
OTHER FEES						\$
TOTAL ADDITIONAL FEE FOR THIS AMENDMENT						\$ 360

Charge \$ 360 to Deposit Account 08-2025. At any time during the pendency of this application, please charge any fees required or credit any overpayment to Deposit Account 08-2025 pursuant to 37 CFR 1.25. Additionally please charge any fees to Deposit Account 08-2025 under 37 CFR 1.16 through 1.21 inclusive, and any other sections in Title 37 of the Code of Federal Regulations that may regulate fees. A duplicate copy of this sheet is enclosed.

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, Washington, D.C. 20231.

Date of Deposit: 31 October 2002

Typed Name: Patrick N. Burkhart

Signature: 

Respectfully submitted,

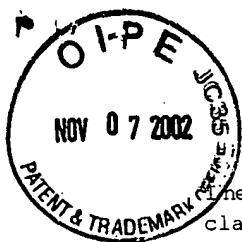
PHILLIPS ET AL.

By 

Patrick N. Burkhart

Attorney/Agent for Applicant(s)
Reg. No. 33,252

Date: 31 October 2002



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Date of Deposit: 31 October 2002

Typed Name of Person Mailing Paper or Fee: Patrick N. Burkhart

Signature: [Signature]

PATENT APPLICATION
DOCKET NO. 10002608-1

*#4/ Response
Haramo
11/19/02*

IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE

RECEIVED
NOV - 8 2002
TECHNOLOGY CENTER 280C

INVENTOR(S): Q. PHILLIPS

SERIAL NO.: 09/924,200

GROUP ART UNIT: 2852

FILED: 08/07/2001

EXAMINER: R. BEATTY

SUBJECT: "CASSETTE LOADING OF PRINTING CONSUMABLES"

COMMISSIONER OF PATENTS
WASHINGTON, D.C. 20231

SIR:

In response to the Office Action mailed 31 July 2002, Applicants submit the following amendment and remarks.

REMARKS

Claims 1 through 20 stand rejected.

Claims 1 through 20 remain in the application.

This amendment is made to place the application into condition for allowance. In the alternative, this amendment is made to place the application into better form for consideration on appeal.

Reconsideration and re-examination of the application are respectfully requested.

THE §112 REJECTION

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01 FC:1202 360.00 CH

Claims 13 through 20 were rejected under 35 USC §112, second paragraph, due to the use of the phrase, "while the door is closed". Applicants respectfully submit that the language of the claims is clear. The claims define an access door and an opening as separate structural claim elements, the coexistence of which is fully supported by the specification, as exemplified by the access door 30 and opening 35 illustrated in Applicants' FIG. 2. Applicants submit that the claims are in compliance with 35 USC §112, and that the rejection should be withdrawn.

THE §102 REJECTION

Claims 1-3, 6, 10-14, 16, 19, and 20 were rejected under 35 U.S.C. §102(b) as being anticipated by Japanese Publication No. 04-184464 to Matsunaga. These rejections, insofar as they may be applied to the claims as amended, are respectfully traversed.

Japanese Publication No. 04-184464 to Matsunaga is directed to a standard copier configuration, in which the access door 30 of a toner cartridge containing device associated with a copier must be opened up to insert toner cartridges (Matsunaga FIG. 7). It is only after the toner cartridge has been inserted into the containing device, and the access door has been re-closed, that the toner cartridges are placed into an in-use position (Matsunaga FIG. 5).

By contrast, each of Applicants' amended claims positively recites structure and function that is simply not present in the Matsunaga document. Matsunaga lacks guide assembly to "receive a consumable-containing cartridge as it is inserted through the opening in the system housing, the guide assembly guiding the consumable-containing cartridge into an in-use position within the printing consumable holding assembly", as required by Applicants' claim 1, lines 9-13. Matsunaga is devoid of a guide assembly that can "receive and grasp a consumable-containing cartridge as it is inserted through the opening in the system housing, the cartridge being configured to be inserted into the opening with the access door of the system in its closed position, as in lines 10-13 of Applicants' Claim 13. Matsunaga fails to teach the steps of "providing a guide assembly connected to the imaging system within the housing, the guide

assembly being adapted to receive and grasp a consumable-containing cartridge as it is inserted through the opening in the system housing; inserting the cartridge into the opening; causing the guide assembly to guide the consumable-containing cartridge into an in-use position within the printing consumable holding assembly; and performing all of the above steps with the access door of the system in its closed position", as in Applicants' Claim 20, lines 9-18.

It is well-established that for a claim properly to be rejected under 35 U.S.C. §102, every element of the claimed invention must be present in the cited reference. As set forth above, Matsunaga fails to teach every element of Applicant's claimed invention as claimed in claims 1-3, 6, 10-14, 16, 19, and 20. Consequently, Applicant respectfully submits that the rejections under 35 U.S.C. §102(b) as applied to claims 1-3, 6, 10-14, 16, 19, and 20 are improper, and should be withdrawn.

THE §103 REJECTION

Claims 4, 5, and 15 were rejected under 35 U.S.C. §103 as being unpatentable over Japanese Publication No. 04-184464 to Matsunaga in view of Tani. Claims 1, 6-9, 13, and 16-18 were rejected under 35 U.S.C. §103 as being unpatentable over Kitajima in view of Kasamura. These rejections, insofar as they may be applied to the claims as amended, are respectfully traversed. Applicant respectfully submits that, for the reasons that follow, the Examiner has failed to establish a prima facie case for obviousness.

In Graham v. John Deere Co., 383 U.S. 1 (1966), the Supreme Court indicated that "under §103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level ordinary skill in the art resolved." 383 U.S. 1 at 17.

SCOPE AND CONTENT OF THE PRIOR ART

The scope and content of **Japanese Publication No. 04-184464 to Matsunaga** is detailed hereinabove.

U.S. Patent No. 4,977, 429 to Tani discusses an apparatus for supplying toner to an imaging apparatus in which an access door 25 is provided to facilitate the removal of a jamming sheet and other operations (Tani Col. 4, lines 38-39). As with other conventional imaging apparatus, a toner cartridge can be inserted through the access door (Tani Col. 4, lines 66-68).

U.S. Patent No. 6,091,912 to Kitajima deals with a toner supplying device in which toner cartridges are inserted through an opening accessible through an access door 6 (Kitajima Col. 9, line 63 through Col. 10, line 12).

U.S. Patent No. 4,611,899 to Kasamura is directed to a developing apparatus having a developer receptacle 22 in a developer device 10 located in a conventional manner within an electrophotographic system (Kasamura FIG. 1, and Col. 2, lines 44-50).

DIFFERENCES BETWEEN THE PRIOR ART AND THE CLAIMS AT ISSUE

Each of Applicants' independent claims recites structure and function that are not found in the references of record. Applicants' claim 1, lines 9-13, recites a guide assembly adapted and constructed to "receive a consumable-containing cartridge as it is inserted through the opening in the system housing, the guide assembly guiding the consumable-containing cartridge into an in-use position within the printing consumable holding assembly". Lines 10-13 of Applicants' Claim 13 set forth a guide assembly that can "receive and grasp a consumable-containing cartridge as it is inserted through the opening in the system housing, the cartridge being configured to be inserted into the opening with the access door of the system in its closed position." Applicants' Claim 20, lines 9-18, requires the steps of "providing a guide assembly connected to the imaging system within the housing, the guide assembly being adapted to receive and grasp a consumable-containing cartridge as it is inserted through the opening in the system housing; inserting the cartridge into the opening; causing the guide assembly to guide the consumable-containing cartridge into an in-use position

within the printing consumable holding assembly; and performing all of the above steps with the access door of the system in its closed position".

These features are lacking entirely from each of the applied references, not one of which even remotely involves the use of a guide assembly and opening, separate from the access door, clearly and directly claimed by Applicants.

THE LEVEL OF ORDINARY SKILL IN THE ART

A person of ordinary skill in the art would never be motivated to modify the toner container with an access door 30 of Matsunaga with the internal toner cartridge of Tani, or the toner supplying device of Kitajima with the developing apparatus of Kasamura, to arrive at the system positively recited in Applicants' claims.

Each of Applicant's claims, as amended, requires structure and function that is not present in any permissible combination of the cited references.

Applicants submit that the question under §103 is whether the totality of the prior art would collectively suggest the claimed invention to one of ordinary skill in this art. In re Merck & Co., Inc., 231 U.S.P.Q. 375 (Fed. Cir. 1986). The answer to this question with respect to Applicant's claimed invention is clearly "no".

It is insufficient that the prior art disclosed the components of the claimed device, either separately or used in other combinations; there must be some teaching, suggestion, or incentive to make the combination made by the inventor. Interconnect Planning Corp. v. Feil, 227 U.S.P.Q. 543, 551 (Fed. Cir. 1988). Individual references cannot be "employed as a mosaic to recreate a facsimile of the claimed invention." Northern Telecom Inc. v. Datapoint Corp., 15 U.S.P.Q. 2d 1321, 1323 (Fed. Cir. 1990).

Even assuming that one of ordinary skill in the art would somehow have combined the references applied by the Examiner, the resultant combination would still lack critical features positively recited in the amended claims. To draw on hindsight knowledge of the patented invention, when the prior art does not contain or suggest that knowledge, is to use the invention as a template for

its own reconstruction -- an illogical and inappropriate process by which to determine patentability. *W.L. Gore & Assoc. v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983). The invention must be viewed not after the blueprint has been drawn by the inventor, but as it would have been perceived in the state of the art that existed at the time the invention was made. *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1138, 227 USPQ 543, 547 (Fed. Cir. 1985). *Sensonics Inc. v. Aerosonic Corp.* (CA FC) 38 USPQ2d 1551, 1553 1996.

With the analysis of the deficiencies of the applied references in mind as enumerated above, there is no reason or suggestion in the evidence of record as to why one of ordinary skill in the art would have been led to produce the claimed invention. Therefore, prima facie obviousness has not been established.

The Examiner has failed to meet the test for obviousness as set forth in Graham v. John Deere Co. Withdrawal of the §103 rejection is in order, and therefore respectfully requested.

In view of the foregoing remarks and amendments, Applicants respectfully submit that claims 1 through 20 define allowable subject matter. The Examiner is requested to indicate the allowability of all claims in the application, and to pass the application to issue.

Respectfully submitted,
(Phillips et al.)

By _____
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31 October 2002
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S/N:09/924,200
Case: 10002608-1
Amendment A